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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/527,275    03/17/00    UNSICKER

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EXAMINER

JIANG, D

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/527,275

Applicant(s)

UNSICKER ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, and 16, drawn to a pharmaceutical composition comprising GDF-5 and NGF, classified in class 424, subclass 198.1.
- II. Claims 1-2, 4, and 16, drawn to a pharmaceutical composition comprising GDF-5 and NT-3, classified in class 424, subclass 198.1.
- III. Claims 1-2, 5, and 16, drawn to a pharmaceutical composition comprising GDNF and TGF-  $\beta$ , classified in class 424, subclass 198.1.
- IV. Claims 1-2, 6, and 16, drawn to a pharmaceutical composition comprising GDF-5 and GDNF, classified in class 424, subclass 198.1.
- V. Claims 1-2, 7, and 16, drawn to a pharmaceutical composition comprising TGF- $\beta$  and FGF-2, classified in class 424, subclass 198.1.
- VI. Claims 1-2, 8, and 16, drawn to a pharmaceutical composition comprising TGF-  $\beta$  and CNTF, classified in class 424, subclass 198.1.
- VII. Claims 1-2, 9, and 16, drawn to a pharmaceutical composition comprising TGF-  $\beta$  and NT-3, classified in class 424, subclass 198.1.
- VIII. Claims 1-2, 10, and 16, drawn to a pharmaceutical composition comprising TGF-  $\beta$  and NGF, classified in class 424, subclass 198.1.
- IX. Claims 1-2, 11, and 16, drawn to a pharmaceutical composition comprising BMP-4 and NGF, classified in class 424, subclass 198.1.
- X. Claims 1-2, 12, and 16, drawn to a pharmaceutical composition comprising BMP-12 and NGF, classified in class 424, subclass 198.1.
- XI. Claims 1-2, 13, and 16, drawn to a pharmaceutical composition comprising BMP-2 and NT-3, classified in class 424, subclass 198.1.
- XII. Claims 1-2, 14, and 16, drawn to a pharmaceutical composition comprising BMP-7 and NT-3, classified in class 424, subclass 198.1.

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XIII. Claims 1-2, and 15-16, drawn to a pharmaceutical composition comprising BMP-12 and NT-3, classified in class 424, subclass 198.1.

The inventions are distinct, each from the other because:

Each of the Inventions listed above encompasses a unique combination comprising physically and functionally distinct chemical entities, thus, non-coextensive searches are required.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matters, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Advisory Information

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



LORRAINE SPECTOR  
PRIMARY EXAMINER

DJ  
5/3/01